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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,618	12/17/2003	Yoshihiro Ohkura	X2007.0147	4069
32172	7590	11/13/2006	EXAMINER	
DICKSTEIN SHAPIRO LLP			NGUYEN, DILINH P	
1177 AVENUE OF THE AMERICAS (6TH AVENUE)			ART UNIT	
NEW YORK, NY 10036-2714			PAPER NUMBER	
			2814	

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/736,618

Applicant(s)

OHKURA, YOSHIHIRO

Examiner

DiLinh Nguyen

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/24/06</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claim 1 and 3-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Furuya et al. (U.S. Pat. 6787892) (newly cited).

Furuya et al. disclose a surface mount chip package incorporating a semiconductor chip having an integrated circuit, comprising:

a package housing 3 made of a resin that covers the semiconductor chip 1 while avoiding a plurality of conductors 2 extending from the semiconductor chip 1 (fig. 1E and claim 1);

a plurality of external electrodes 51b, 52b or 53b that are arranged in the package housing 3 in correspondence with a main surface of the semiconductor chip having the integrated circuit and are connected with the plurality of conductors extending from the semiconductor chip; the external electrodes 53b each having a circular shape when viewing the chip package externally in a vertical direction when the semiconductor chip is held horizontally (figs. 3-5); and

at least one marking member 51a, 52a or 53a that is arranged in the package housing so as to realize a directivity when viewing the chip package externally in the

vertical direction, wherein an outline shape of the marking member includes at least one linear portion as viewing the chip package externally in the vertical direction (figs 3-5, column 5, lines 30-50 and claim 1).

- Regarding claim 3, Furuya et al. disclose that the marking member 51a corresponds to a copper post 2 that is arranged independently of the plurality of conductors (column 5, lines 42-47).
- Regarding claim 4, Furuya et al. disclose that the copper post serving as the marking member has a square shape (fig. 3 and claim 4).
- Regarding claim 5, Furuya et al. disclose that the copper post is covered with a solder layer thus realizing the marking member (column 4, lines 53-54).
- Regarding claim 6, Furuya et al. disclose that the marking member has a square shape (fig. 3, claim 4).
- Regarding claim 7, Furuya et al. disclose that the copper post is increased in size compared with each of the plurality of conductors (fig. 5).
- Regarding claims 8-9, Furuya et al. disclose that the copper post servings as the marking member is increased in size compared with each of the plurality of conductors, which correspond to a plurality of copper posts (fig. 5).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-9 have been considered but are moot in view of the new ground(s) of rejection. See the new grounds of rejection above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DiLinh Nguyen whose telephone number is (571) 272-1712. The examiner can normally be reached on 8:00AM - 6:00PM (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2814

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DLN

A handwritten signature in black ink, appearing to read 'Hoai Pham', with a long horizontal flourish extending to the right.

HOAI PHAM  
PRIMARY EXAMINER